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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,472	02/05/2004	Kenichi Sakamoto	NIT-408	2953
7590 Mattingly, Stanger & Malur, P.C. Suite 370 1800 Diagonal Road Alexandria, VA 22314			EXAMINER SCUDERL, PHILIP S	
			ART UNIT 2153	PAPER NUMBER
			MAIL DATE 04/29/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/771,472

Applicant(s)

SAKAMOTO ET AL.

Examiner

Philip S. Scuderi

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2008 and 03 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-5, 8, 9 and 13-15 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3, 4, 8, 9, 13 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Claims 5 and 15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 4/1/2008.

Response to Arguments

Applicant's arguments filed 1/28/2008 (herein "Remarks") in regards to the Mulahusic reference ("SIP Issues in Dual-stack Environments", Mulahusic et al., 2/27/2003) have been fully considered but they are not persuasive.

Applicant argues that "at no point is there any teaching or suggestion in Mulahusic of the dual registration of an IPv4 terminal and an IPv6 terminal such as illustrated in Fig. 5 of the present application as step 81." (Remarks at pp. 10).

The examiner finds this argument unpersuasive for the following reasons.

The limitation at issue is recited in claim 1 and states "said receiving unit receives a packet having each of registration information for an IPv4 terminal and registration information for an IPv6 terminal."

Mulahusic shows a dual-stack (IPv4/IPv6) host (Alice) in figure 1 that uses the Session Initiation Protocol (SIP). (See Mulahusic at pp. 3-4). Figure 1 shows that this host (Alice) initiates the session by issuing an "INVITE (IPv6)" message. Mulahusic states in the first paragraph under the section titled "Scenario I, First try IPv6 and if error try IPv4" on page 3 that "[t]he host initiating the session is registered with its SIP server with both IPv4 and IPv6 addresses." It follows that the

dual-stack host in figure 1 (Alice) registered by issuing a registration message in accordance with SIP. Such a registration message necessarily includes "registration information" for an IPv4 terminal and an IPv6 terminal because Alice's terminal is a dual-stack (IPv4 and IPv6) terminal.

Based upon applicant's arguments it appears applicant either (1) overlooked the passage that states that "[t]he host initiating the session is registered with its SIP server with both IPv4 and IPv6 addresses" or (2) interprets the limitation at issue to require IPv4 registration information and separate IPv6 registration information in the same packet. It is noted that the limitation at issue does not limit the claimed "registration information" to being IPv4 registration information and separate IPv6 registration information. Any registration information in the registration packet can reasonably be considered "registration information for an IPv4 terminal and registration information for an IPv6 terminal" because Alice's terminal is both an IPv4 and an IPv6 terminal. (See Mulahusic at fig. 1). Applicant is reminded that "[d]uring patent examination, the pending claims must be 'given their broadest reasonable interpretation consistent with the specification'." (MPEP 2111, with emphasis added).

Moreover, even if the claims were narrowed to require a single packet containing separate IPv4 and IPv6 registration information, this feature would ultimately be obvious under section 103. The examiner has enclosed RFC 3261 because it describes SIP registration messages in Chapter 10, called "REGISTER Requests." REGISTER Requests comprise a "Contact" field that contains the addresses that a host wishes to register. (RFC 3261 at pp. 57). It is clear that this field can contain multiple addresses because RFC 3261 states on page 61 that "[i]f more than one Contact is sent in a REGISTER request, the registering UA intends to associate all of the URIs in these Contact header field values with the address-of-record present in the To Field." The skilled artisan would readily appreciate that using a single registration packet would be beneficial because, *inter alia*, doing so

would avoid the unnecessary network congestion associated with sending multiple registration packets.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 3, 8, and 13 are rejected under 35 U.S.C. 102(a) as being anticipated by Mulahusic (“SIP Issues in Dual-stack Environments”, Mulahusic et al., 2/27/2003).

As to claim 3, Mulahusic teaches a session control system (SIP server) comprising:
a control unit for performing a process of establishing a session between communication terminals (hosts) connected to an IP network [see Scenario I shown on pages 3-4 and in Figure 1];

a receiving unit for receiving, from a first communication terminal (e.g., Alice's host), a session control request packet (Invite) to a second communication terminal (e.g., Bob's host) [see Scenario I shown on pages 3-4 and in Figure 1]; and

a transmitting unit for transmitting a notification (e.g., “Error Try(IPv4)”) to said first communication terminal (e.g., Alice's host) if an IP protocol version (IPv6) of said session control request packet (Invite) is different from an IP protocol version (IPv4) usable by said second communication terminal (e.g., Bob's host) [see Scenario I shown on pages 3-4 and in Figure 1],

wherein said receiving unit receives a packet having each of registration information for an IPv4 terminal and registration information for an IPv6 terminal [see the first paragraph of Scenario I

on page 3 (“The host initiating the session is registered with its SIP server with both IPv4 and IPv6 addresses.”)].

As to claim 8, Mulahusic teaches a communication terminal (e.g., Alice’s host) connected to a session control system (SIP server) via an IP network and capable of communication using the IPv4 protocol and communication using the IPv6 protocol, comprising:

a transmitting unit for transmitting to said session control system (SIP server), by using the IPv4 or IPv6 protocol (IPv6), a session control request (Invite) for requesting a session control to a communication terminal (e.g., Bob’s host) to be a communication partner [see Scenario I shown on pages 3-4 and in Figure 1]; and

a receiving unit for receiving a notification (“Error Try(IPv4)”) indicating that the communication protocol (IPv6) used for said session control request (Invite) is different from a communication protocol (IPv4) communicable with the communication terminal (e.g., Bob’s host) to be said communication partner [see Scenario I shown on pages 3-4 and in Figure 1], wherein

upon receiving the notification (“Error Try(IPv4)”), a session control request (Invite) for requesting a session control to the partner communication terminal (e.g., Bob’s host) is transmitted again by using a communication protocol (IPv4) communicable with the partner communication terminal (e.g., Bob’s host) [see Scenario I shown on pages 3-4 and in Figure 1], and

wherein said transmitting unit transmits to said session control system a registration packet in which both of registration information for an IPv4 terminal and registration information for an IPv6 terminal is described [see the first paragraph of Scenario I on page 3 (“The host initiating the session is registered with its SIP server with both IPv4 and IPv6 addresses.”)].

As to claim 13, Mulahusic teaches a network system comprising an IP network, first and second communication terminals (e.g., Alice's and Bob's hosts) each connected to the IP network, and a session control system (SIP server) connected to the IP network, wherein

said first communication terminal (e.g., Alice's host) has a transmitting unit capable of transmitting a session control request (Invite) to said second communication terminal (e.g., Bob's host) by using each of an IPv4 packet and an IPv6 packet [see Scenario I shown on pages 3-4 and in Figure 1], and

said session control system (SIP server) is comprised of:

a session control unit for establishing a session between said first and second communication terminals (e.g., Alice's and Bob's hosts) [see Scenario I shown on pages 3-4 and in Figure 1];

a receiving unit for receiving the session control request (Invite) transmitted from said first communication terminal (e.g., Alice's host) [see Scenario I shown on pages 3-4 and in Figure 1]; and

a transmitting unit for transmitting to said first communication terminal (e.g., Alice's host), if an IP protocol version (IPv6) of said session control request (Invite) is different from an IP protocol version (IPv4) usable by the second communication terminal (e.g., Bob's host), a notification ("Error Try (IPv4)") indicating that the IP protocols (IPv4 and IPv6) are different [see Scenario I shown on pages 3-4 and in Figure 1],

wherein the transmitting unit of said first communication terminal (e.g., Alice's host) transmits to said session control system a registration packet in which each of registration information for an IPv4 terminal and registration information for an IPv6 terminal is described [see the first paragraph of Scenario I on page 3 ("The host initiating the session is registered with its SIP server with both IPv4 and IPv6 addresses.")], and

wherein the receiving unit of said session control system accepts the packet including said registration information and transmitted from said first communication terminal (e.g., Alice's host) [see the first paragraph of Scenario I on page 3 ("The host initiating the session is registered with its SIP server with both IPv4 and IPv6 addresses.")].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 9, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Mulahusic.

As to claims 4, 9, and 14, Mulahusic discloses that the hosts register at their SIP servers [see the first paragraph of Scenario I on page 3]. It follows that the hosts must inherently send a packet to the server to perform this registration. However, the reference does not expressly or inherently teach that such a registration packet is "an IPv4 packet or an IPv6 packet" as recited in the claim.

Nonetheless, the registration packets must have been formatted using some format compatible with the network. It would have been obvious for the ordinary artisan to try formatting the host's registration packets in the format the host is attempting to register, as the skilled artisan has good reason to pursue the known options within his or her technical grasp. And, it would have been well within the ordinary artisan's technical grasp to make the registration packets IPv4

and/or IPv6 packets because Mulahusic discloses throughout the reference that the hosts communicate other packets using IPv4 and/or IPv6.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

IPv4/IPv6 SIP internetworking methods in dual-stack network, by Kawarasaki et al., discloses a "Register message that contains both IPv4 and IPv6 contact addresses." (See page 1127, first paragraph under the section titled "Registrar method").

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PHILIP S. SCUDERI whose telephone number is (571)272-5865. The examiner can normally be reached on Monday-Friday 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton B. Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Glenton B. Burgess/
Supervisory Patent Examiner, Art Unit 2153

/P.S./